

Art Unit: 3774

The indicated allowability of claims 72-74 and 84-89 is withdrawn in view of the newly discovered reference(s) to Eaton et al (US 5,871,504) and Pierce (US 5,324,308). Rejections based on the newly cited reference(s) follow.

Upon review of the parent applications, it was determined that claims 61-67, 72, 75, 76, 82, 84, and 95 have an effective filing date of July 3, 1997, and claim 68, 69, 73, 74, 77-81, 83, and 85-89 have an effective filing date of November 21, 1997.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 61-69, 75-83, and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholson et al (US 5,725,529) in view of Goble et al (US 4,870,957). Nicholson discloses a method of anchoring soft tissue within bone by inserting a stabilizing element (member (10) of Nicholson), threading a suture attached to soft tissue through an aperture of an insertion element (see Figures 5, 7, and 10 as well as column 8, line 47 et seq.), and then inserting the insertion element into the stabilizing element by deformably expanding it (see column 10, lines 29-67). However, Nicholson fails to teach threading the soft tissue through the aperture. Goble teaches that it was known to thread soft tissue (37) and a suture (stint (38)) together through an aperture in

Art Unit: 3774

a similar anchor system; see the abstract and column 6, lines 26-38. Therefore, it is the Examiner's position that it would have been *prima facie* obvious to thread the soft tissue and suture together or the soft tissue only through the aperture of Nicholson (1) for the same reasons that Goble does the same or (2) to avoid an additional soft tissue-to-suture attachment step when one is not needed. This change would shorten and simplify the procedure.

With regard to claims 63 and 66, the Applicant is directed to see Figure 3.

With regard to claim 65, the Applicant is directed to see column 7, line 46 et seq.

With regard to claim 69, Goble teaches that utilizing a second anchoring system was known when an ACL replacement is performed. It is the Examiner's position that it would have been obvious to an ordinary artisan to attach the other end of the Nicholson tendon or soft tissue to bone in the same manner when repairing an ACL injury.

Claims 72-74 and 84-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholson and Goble as applied to claims 61-69, 75-83, and 95 above, and further in view of Pierce (US 5,324,308) or Le et al (US 5,486,197).

Nicholson fails to disclose the step of pulling the anchor into place as claimed.

However, Pierce (see the paragraph bridging columns 1 and 2) or Le (see the abstract) teaches that it was known to utilizing pulling forces and sutures in order to insert core elements into their outer sheaths. Therefore, it is the Examiner's position that it would have been obvious to utilize a pulling force on an insertion element in order to insert it into a stabilizing element for the same reasons that Pierce or Goble does the same or in

Art Unit: 3774

order to provide a second means to make the connection in additional to the first means of pushing.

Claims 73, 74, and 85-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eaton et al (US 5,871,504) in view of Treace (US 3,953,896) or Parr et al (US 4,744,793) or Goble et al (US 4,870,957). Eaton discloses a method of drilling openings in bone, inserting a stabilization device or sleeve (24) into the opening, threading a graft through an aperture in the head, and then pulling the distal end of an insertion device (26) into the sleeve (24) that has a screw hole on the distal end; see the drawings and column 5, line 24 to column 6, line 65. However, Eaton fails to disclose the utilization of this method to secure the other end of the graft to the other location desired. However, Treace (see the figures) or Parr (see Figure 1) or Goble (see Figures 3 to 5 each teaches that it was known to utilize identical anchoring means on opposite sides of a graft that extends between bones. Therefore, it is the Examiner's position that it would have been obvious to utilize the same graft anchor means of Eaton on both sides of the graft for the same reasons that the secondary references do the same or in order to simplify the process.

### ***Response to Arguments***

The Applicant argues that one would use the preferred emplacement apparatus of Nicholson to install the soft tissue, and that use would cause problems during use because tissue is not the same as suture material. In response, the Examiner asserts that the Applicant has read Nicholson too narrowly. The apparatus of Nicholson is merely a preferred apparatus so it not fair to interpret it as a requirement of the method;

Art Unit: 3774

see column 16 of Nicholson. Nicholson is not limited to that particular apparatus so it is not reasonable to limit the disclosure thereof to that particular method step. Moreover, Goble teaches a method step of inserting soft tissue into an aperture that may be more logical to use than the method step of Nicholson. Goble teaches that the ligament of stint and ligament can simply be strung through the eyelet; see column 3, lines 7-18. Therefore, the Applicant's arguments have not been considered persuasive and the rejection has been maintained.

### ***Conclusion***

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3774

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/  
Paul Prebilic  
Primary Examiner  
Art Unit 3774